

REMARKS

Claims 1, 4, 7-10, 19 and 21 are all the claims pending in the application.

The claims are amended to delete the recitations of “N-oxide thereof” solvate thereof” and “prodrug thereof”.

No new matter is presented.

I. Status of the Claims

For the record, Applicants respectfully request the Examiner to confirm that claim 10 is being examined along with the compound claims.

Also at page 2 of the Action, the Examiner states that claim 8 is allowed, which appears to be an error since the new rejection under 35 U.S.C. § 112 in paragraph 8 of the Action at pages 3-4 clearly indicates that claim 8 is rejected. Applicants respectfully request clarification of this matter for the record.

II. Response to Claim Rejections Under 35 U.S.C. § 112

A. Written Description and New Matter

In paragraph 7, claim 1 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner asserts that the added recitation, “provided that 9-benzyl-1,3-dimethyl-1,3,9-triazaspiro[5.5]undecan-2-one; 1,3-dimethyl-1,3,9-triazaspiro[5.5]undecan-2-one; 9-benzyl-1-methyl-1,3,9-triazaspiro[5.5]undecan-2-one; and 1-methyl-1,3,9-triazaspiro[5.5]undecan-2-one are excluded”, was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the Application was filed, had possession of the claimed invention. Specifically, the

Examiner states that negative provisos within a claim are not permitted unless the explicit negative proviso is described within the specification as well.

Applicants respectfully traverse the rejection.

First, Applicants respectfully submit that the Examiner has no legal basis for the assertion that “negative provisos within a claim are not permitted unless the explicit negative proviso is described within the specification as well”. Negative limitations and exclusionary provisos are permitted in the claims if there is basis in the original disclosure (see MPEP § 2173.05(i)). Specifically, if alternative elements are positively recited in the specification they may be explicitly excluded in the claims. Additionally, MPEP §2173.05(i) specifically states that a lack of literal basis in the specification for a negative limitation is not sufficient to establish a *prima facie* case for lack of descriptive support. See also, for example, the attached Board Decision, *In re Saidi*, Appeal No. 2007-0292, App. No. 10115,802, August 6, 2007, which states: “The §112, first paragraph, rejection is based on the Examiner’s belief that the written description requirement is violated because the Specification disclosure does not expressly contain the claim 31 proviso language. *This belief is in error.*” (emphasis added). See the paragraph bridging pages 3-4 of the Decision.

Additionally, Applicants submit that present claim 1 satisfies the written description requirement and does not introduce new matter sine the proviso added to claim 1 merely narrows the scope of claim 1 by excluding certain species compounds, which are generically disclosed and supported by the description in the specification of formula (I) prior to the amendment adding the proviso. That is, Applicants specification having described the whole (i.e., all of the species of formula (I) as recited in claim 1 prior to the amendment adding the proviso)

necessarily describes the part remaining (i.e., the more limited species defined by present claim 1 with the proviso). See *In re Johnson* 5548 F.2d 1008, 1019 (CCPA 1977), where the court found that in adding a proviso excluding certain species within the scope of the generic formula, applicants were not claiming “new matter”.

In view of the above, Applicants submit that there is no requirement that a negative proviso is explicitly described in the specification and present claim 1 is adequately supported by the specification as originally filed.

B. Enablement

In paragraph 8, claims 1, 4, 7-10 and 21 are rejected under 35 U.S.C. § 112, first paragraph, because the specification, while being enabling for compounds, a salt thereof, or a quaternary ammonium salt thereof, the Examiner asserts that the specification does not reasonably provide enablement for N-oxides thereof, solvates thereof, or prodrugs thereof.

The claims are amended herein by deleting the recitations of “N-oxides thereof”, “solvates thereof”, or “prodrugs thereof”, thereby obviating this ground for rejection.

Accordingly, Applicants respectfully request withdrawal of the §112, first paragraph, rejections.

III. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: March 12, 2008